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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/644,551

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Lisa Schmitt

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BIRDWELL & JANKE, LLP  
1100 SW SIXTH AVENUE  
SUITE 1400  
PORTLAND, OR 97204

EXAMINER

BUI, LUAN KIM

ART UNIT

PAPER NUMBER

3728

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/644,551

Applicant(s)

SCHMITT, LISA

Examiner

Luan K. Bui

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-9 and 16-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-9 and 16-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1, 3-9 and 16-30 are finally rejected under 35 U.S.C. 101 because claim 1 as amended i.e. "filling the compartments to respective said fill levels, where said substance is thereafter frozen in said compartments into a solid state, can be emptied out of the container through said openings in the solid state" is directed a combination of structural elements and a method step. Applicant is claiming the method step with the structural elements, applicant had invoked the 101 and 112, 2<sup>nd</sup> paragraph, under the analysis set forth in Ex parte Lyell, 17 USPQ2d 1548 (Bd. Pat. App. & Int. 1990). In Ex parte Lyell, it is noted that "while it has long been settled that a single patent may include claims directed to more than one statutory class of invention (e.g., a claim to an apparatus and a separate claim to a method of using or producing the apparatus), we find no basis for permitting a combination of two separate and distinct statutory classes of invention in a single claim." Also, patents are authorized by statute and Congress has indicated that inventions may be patentable only if they fall within *one* of the statutory classes of subject matter specified in 35 USC 101, e.g., "process, machine, manufacture or composition of matter," see *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 483, 181 USPQ 673, 679 (1974). A claim is single and is either for a process or product. If the claim were divisible, one part would be for a process and the other for a manufacture and it might be in danger of being held void for ambiguity. An applicant for a patent may separately claim a patentable process and a patentable product, but cannot properly cover them both in one claim.

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They are proper subjects of separate and distinct claims. Therefore, applicant's claim is purported to be ambiguous and indeterminable under the statute.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 3-9 and 16-30 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, the phrase "filling the compartments to respective said fill levels, where said substance is thereafter frozen in said compartments into a solid state, can be emptied out of the container through said openings in the solid state" is ambiguously constructed and indeterminate in scope because it is claiming an apparatus and method of using the apparatus in a single claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3, 4 and 16-18 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Donoghue (3,347,420). To the extent that the Examiner can determine the scope of the claims, Donoghue discloses a measuring and storage container comprising a plurality of

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compartments (16, 18) having respective openings (36, 38), each of the compartments having a maximum filling elevation in a stable orientation of the container (top edge of the compartment) and an indicia (54) indicating the position of at least one fill level and the at least one fill level is at a level below the respective maximum filling elevation (Figures 2 and 4). The openings of Donoghue are inherently capable to receive a substance in a liquid state.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-6 and 16-20 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Spreen (1,688,887) in view of Fraenkel (6,311,500) and Shepherd (2,863,305) or Hughes (5,520,278). To the extent that the Examiner can determine the scope of the claims, Spreen discloses in the embodiment of Figure 4, a storage container (11) for forming ice blocks comprising a plurality of compartments formed by removable partitions (17) defining respective maximum filling elevations thereof (top edges of the compartments) in a stable orientation of the container and the compartments having respective opening configured to receive a substance in a liquid state. Spreen also discloses the other claimed limitations except for the compartments comprise indicia indicating the position of at least one fill level below the maximum filling elevation.

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Fraenkel teaches a storage container (10, 20, 100) for forming ice blocks comprising a plurality of compartments (12, 22) defining respective maximum filling elevations thereof (top edges of the compartments) in a stable orientation of the container. Fraenkel further discloses each compartment may not be filled to the top but rather about six percent of the compartment may be left empty to allow the water in the compartment to expand during freezing (column 2, lines 45-48) which is considered equivalent to the at least one fill level is at a level below the respective maximum filling elevation. Shepherd shows a transparent bag (11) having indicia (12) indicating the position of at least one fill level of water (14) into the bag. Hughes shows a measuring cup/container (10, 18) comprising a compartment having a top edge/maximum filling level and at least one indicia indicating the position of at least one fill level below the maximum filling level.

It would have been obvious to one having ordinary skill in the art in view of Fraenkel and Shepherd or Hughes to modify the container of Spreen so each compartment includes at least one fill level disposed below the maximum filling elevation as taught by Fraenkel to allow the water in the compartment to expand during freezing and the at least one fill level comprises indicia indicating the position of the at least one fill level as taught by Shepherd or Hughes to provide more convenient for the user when filling the compartments.

As to claims 3 and 4, Fraenkel discloses the container formed from a transparent plastic material and the compartments are integrally molded with the container.

As to claim 16, Hughes shows more than one indicia indicating the positions of fill levels.

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9. Claims 7-9 and 21-30 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1 and 16 above, and further in view of Andress et al. (5,356,026; hereinafter Andress'026). To the extent that Spreen further fails to show multiple instances of the container being stackable and each of the multiple instances of the container includes a lid being adapted to snap-fit onto the container, Andress'026 suggests a container assembly (10) comprising a container (12) and a lid (11) adapted to snap-fit (52, 55, 60, 61). Andress'026 further suggests the container includes a bottom surface (25-27) complementary to the lid (13, 14) so that multiple instances of the container with the lid fitted thereon are stackable. It would have been obvious to one having ordinary skill in the art in view of Andress'026 to modify the container of Spreen as modified so the container includes a lid adapted to snap-fit onto the container for better securing the contents within the container and the container are stackable to reduce space during storage.

### ***Response to Arguments***

Applicant's arguments filed on 3/9/2007 have been fully considered but they are not deemed to be persuasive.

Applicant's arguments in the remarks are noted. They are not persuasive for the same reasons as set forth above and the Office Action mailed on 11/14/2006.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is 571-272-4552. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

lkb  
April 19, 2007



Luan K. Bui  
Primary Examiner  
Art Unit 3728